

Neifeld Docket No: PIP-69A-KATZ

BPAI appeal docket no: 2008-5179.

Application/Patent No: 09/776,714

USPTO CONFIRMATION NO: 2896

File/Issue Date: 2/6/2001

Inventor/Title: Gary M. KATZ/Method and System for Timing Promotions Based on a Prior Receipt of Promotions

Examiner/ArtUnit: ALVAREZ/3688

**37 CFR 1.7(c) FILING RECEIPT AND TRANSMITTAL LETTER WITH
AUTHORIZATION TO CHARGE DEPOSIT ACCOUNT**

1. THE COMMISSIONER IS HEREBY AUTHORIZED TO CHARGE ANY FEES WHICH MAY BE REQUIRED, OR CREDIT ANY OVERPAYMENT, TO DEPOSIT ACCOUNT NUMBER 50-2106.

2. FEES PAID HEREWITH BY EFS CREDIT CARD SUBMISSION: \$80

A. CLAIMS FEES

\$ - (claims previously paid for; currently present; \$52 per addl. claim over 20.)

\$ - (independent previously paid for; currently present; \$220 per addl. claim over 3)

B. OTHER FEES

3. THE FOLLOWING DOCUMENTS ARE SUBMITTED HEREWITH:

AUTHORIZATION TO CHARGE DEPOSIT ACCOUNT 50-2106 \$80 (1 page)

37 CFR 1.181(A)(3) PETITION

Attachment 1 - Pages 3-6 of Office Action dated 11/18/2008

Attachment 2 - Page 12 of appeal brief filed 4/7/2005

4. FOR INTERNAL NEIFELD IP LAW, PC USE ONLY

USPTO CHARGES: \$ CLIENT BILLING MATTER: PIP-69A-KATZ BANK ACCOUNT/Check: 6/ G/L ACCOUNT: 5010	FIRM CHARGES: \$ DESCRIPTION: FIRM CHARGE FOR LAWYER:
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INITIALS OF PERSON WHO **ENTERED** ACCOUNTING DATA: RAN

ATTORNEY SIGNATURE (AUTHORIZING DEPOSIT ACCOUNT) /RichardNeifeld#35,299/

Printed: December 9, 2008 (10:41am)

Richard Neifeld

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37 CFR 1.181(A)(3) PETITION TO HAVE THE OFFICE ACTION DATED 11/18/2008
WITHDRAWN FOR FAILURE TO COMPLY WITH 37 CFR 1.104(c)

I. RELIEF REQUESTED

The applicant has noted in the appeal brief to be filed after this petition that the issue of what constitutes a prima facie rejection could be subject to a precedential decision. Similarly, the applicant requests the Director to note the decision on this petition precedential or otherwise have it distributed as guidance to the examining corps.

The applicant requests the office action be withdrawn and other such relief as the Director may determine addresses the procedural failure, because the office action's 102 rejections fail to comply with 37 CFR 1.104(c)((1) and (2).

II. RELEVANT FACTS

1. The applicant has repeatedly noted on the record that the basis for rejection under 35 USC 102 based upon Swix is deficient, failing to make a prima facie case. Attachment 2 is a copy of page 12 of appeal brief filed 4/7/2005 showing that applicant identified the 102 rejections based upon the Swix patent as failing to make a prima facie case.

2. The examiner has continued to fail to specify on the record the basis for the 102 rejections in the manner required by 37 CFR 1.104(c). Attachment 2 is a copy pages 3-6 of the office action dated 11/18/2008 showing that failure.

3. 37 CFR 1.104(c)(1) and (2) states that:

(c) Rejection of claims.

(1) If the invention is not considered patentable, or not considered patentable as claimed, the claims, or those considered unpatentable will be rejected.

(2) In rejecting claims for want of novelty or for obviousness, the examiner must cite the best references at his or her command. When a reference is complex or shows or describes inventions other than that claimed by the applicant, the *particular part relied on must be designated as nearly as practicable. The pertinence of each reference, if not apparent, must be clearly explained and each rejected claim specified.* [Emphasis added.]

4. The office action dated 11/18/2008, in the paragraph spanning pages 3 and 4, identifies the basis for rejection under 35 USC 102 of some 36 claims (claims 1-3, 7, 9-15, 19-21, 23-25, 27-36, 39-42, 45-46, 62-65) solely as:

With respect to claims 1-3, 7, 9-15, 19-21, 23-25, 27-36, 39-42, 45-46, 62-65 Swiss teaches a computer implemented method (Abstract). Receiving identification information from a consumer (Figure 2, 210); identifying, based upon said received identification information, one or more parameters related to promotions received by said consumer (Figure 3, 302); determining a time at which promotions is to be provided based upon said identified one or more parameters related to promotions received by said consumer (col. 10, lines 52 to col. 11, lines 1-3).

5. The paragraph spanning pages 3 and 4 in the office action dated 11/18/2008 fails to specifically correlate any disclosure in the reference, Swix, to any claim.

6. The limitations purportedly addressed in the foregoing passage correspond generally to those in independent claim 1.

7. The limitations purportedly addressed in the foregoing passage fail to correspond to limitations in many of the other claims identified in the first paragraph of the foregoing passage.

III. REASONING

The applicant has repeatedly identified the failing of the explanation of the repeated 102 rejections over Swix, to the examiner, in prior filings in response to the repeated 102 rejections over Swix, giving the examiner ample opportunity to cure the failings in the office actions, - - to specify what in Swix discloses claimed limitations. For example, the appeal brief filed 4/7/2005 contained a section entitled "The Examiner Has Not Presented a Prima Facie Case For The 35 USC 102(e) Rejections Of Claims 3, 7, 9-15, 19-21, 23-25, 27, 29-36, 39-42, 45-46 And 62-65".

Similarly, the applicant addressed in detail the rejections based upon Swix in the amendment filed October 7, 2004, which included a section titled "The Examiner Has Not Shown, And Swix Does Not Disclose, The Limitations Of Dependent Claims 2, 3, 7,9-15, 19-21,23-25,27, 29-32,34-36,39-42, And 45-46 And Independent Claim 33." The office action fails to address those repeated prior assertions by clarifying the basis for rejection under 102 of each claim.¹

Take as an example claim 23. Claim 23 is one of the 36 or so claims rejected under 102 cited only in the paragraph spanning pages 3 and 4 of the office action. Claim 23 recites "The method according to claim 1, wherein said step of determining said time at which said promotion is to be provided comprises *determining a value of said promotions recently received by said consumer.*" There is no discussion in the office action, much less in the paragraph spanning pages 3 and 4, of anything remotely related to the concept defined by claim 23. Yet claim 23 is rejected under 35 USC 102.

The office action fails to comply with 37 CFR 1.104 because it fails to identify "the *particular part relied [upon] ... designated as nearly as practicable*" for the 102 rejections of claims 1-3, 7, 9-15, 19-21, 23-25, 27-36, 39-42, 45-46, 62-65 and the office action does not explain the "*pertinence of ...[Swix for] each rejected claim specified*" for the 102 rejections. of claims 1-3, 7, 9-15, 19-21, 23-25, 27-36, 39-42, 45-46, 62-65. Such an office action fails to comply with the minimum standard required to identify to the applicant the basis for rejection under 102 of each claim.

DATE: 12/9/2008

/RichardNeifeld#35,299/

Richard Neifeld, Reg. No. 35,299

¹The prior examiner's answer contained a "response to argument" section which appeared to address some of the applicant's arguments. See answer dated 6/7/2005 pages 10-11. However, the examiner has not maintained those arguments into the current office action, for the good reasons noted in appellants reply brief filed 12/26/2007. That reply brief stated, in toto, "In response to the examiner's answer mailed December 14, 2007, the applicant notes that the examiner's answer reiterates the arguments in the office action appealed from. It contains no new arguments. In response, the applicant notes that the examiner's arguments are addressed in the appeal brief."

Attorney of record

ran

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statutory class (such as a particular apparatus or physical module or device) or does not transform the underlying subject matter (such as an article or materials) to a different state or thing. See MPEP §2106.IV.B: *Determine Whether the Claimed Invention Falls Within An Enumerated Statutory Category*.

Examiner suggests applicant inserts a device in one or more steps of the body of the claims in order to overcome this rejection.

¹ Diamond v. Diehr, 450 U.S. 175, 184 (1981); Parker v. Flook, 437 U.S. 584, 588 n.9 (1978); Gottschalk v. Benson, 409 U.S. 63, 70 (1972); Cochrane v. Deener, 94 U.S. 780, 787-88 (1876).

² The supreme court recognized that this test is not necessary fixed or permanent and may evolve with technological advances. Gottschalk v. Benson, 409 U.S. 63,71 (1972)

Claim Rejections - 35 USC § 102

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

4. Claims 1-5, 7, 9-21, 23-36, 39-42 and 44-46, 62-65 are rejected under 35 U.S.C. 102(e) as being anticipated by Swix et al. (6,718,551 hereinafter Swix).

With respect to claims 1-3, 7, 9-15, 19-21, 23-25, 27-36, 39-42, 45-46, 62-65 Swiss teaches a computer implemented method (Abstract). Receiving identification information from a consumer (Figure 2, 210); identifying, based upon said received identification information, one or more parameters related to promotions received by

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said consumer (Figure 3, 302); determining a time at which promotions is to be provided based upon said identified one or more parameters related to promotions received by said consumer (col. 10, lines 52 to col. 11, lines 1-3).

With respect to claims 4 5, Swix further teaches that one or more parameters related to said promotions received by said consumer relate to a product class/product industry of said promotions received by said consumer (Figure 3).

With respect to claim 16, Swix further teaches selecting a targeted promotion from a plurality of potential promotions based upon said one or more characteristics of said consumer, said determine d time being for said targeted promotion (col. 12, lines 22-90).

With respect to claims 17-18, Swix further teaches selecting said targeted promotion comprises matching said one or more characteristics of said consumer to a desired consumer profile (col. 12, lines 22-60).

With respect to claims 26 and 44, Swix further teaches determining said time at which said promotion is to be provided comprises determining at least one of a demographic and a purchase characteristic of said consumer (col. 12, lines 22-60).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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5. Claims 6, 22, 38, 47-61 rejected under 35 U.S.C. 103(a) as being unpatentable over Swix.

Claim 6, 22, 38 further recites that the promotions received by said consumer relate to a location where the promotions can be exercised by the consumer. Official notice is taken that it is old and well known for promotions to have a location in which it can be redeemed in order to promote patronage of an establishment. It would have been obvious a person of ordinary skill in the art at the time of Applicant's invention to have included the promotions received by said consumer relate to a location where the promotions can be exercised by the consumer in order to obtain the above mentioned advantage.

Claims 8 and 37 further recites a promotion validity date. Official notice is taken that it is old and well known for offers to have a validity date in which the offers can be redeemed in order allow promoters/manufacture to better manage the offers. It would have been obvious to a person of ordinary skill in the art at the time of Applicant's invention to have included recites a promotion validity date in order to obtain the above mentioned advantage.

Claim 43 further recites that the promotions have a time of receipt record. Official notice is taken that it is old and well known in the computer related arts to time stamp information received in order to keep track of when the information was received. It would have been obvious to a person of ordinary skill in the art at the time Applicant's invention to have included promotions time receipt record in order to obtain the above mentioned advantage.

Claims 47-58 recite well known forms and methods of distributing offers and would therefore have been obvious to one of ordinary skill in the art to use such a known form of advertisement.

With respect to claims 59-61 Swix teaches a computer implemented method (Abstract). Receiving identification information from a consumer (Figure 2, 210); identifying, based upon said received identification information, one or more parameters related to promotions received by said consumer (Figure 3, 302); determining a time at which promotions is to be provided based upon said identified one or more parameters related to promotions received by said consumer (col. 10, lines 52 to col. 11, lines 1-3). Swix doesn't specifically teach that the receiver is at a vendor location site at a check-out counter in a store. Official Notice is taken that it is old and well known for consumers to identify themselves at the checkout counter at a vendor location site in order to receive promotions/offers based on their current purchases. It would have been obvious to a person of ordinary skill in the art at the time of Applicant's invention to have included the receiver being located at a vendor location site at a check-out counter in a store in order to achieve the above mentioned advantage.

Point of contact

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Raquel Alvarez whose telephone number is (571)272-6715. The examiner can normally be reached on 9:00-5:00.

standard video broadcast. Accordingly, Swix also does not disclose determining a time to provide a promotion based upon a parameter related to promotions received by consumer.

In summary, Swix does not disclose determining a time to provide a promotion, wherein the determined time is based upon identified parameters related to promotions received by the customer, as defined by claims 1 and 28. Therefore, the rejections of claims 1 and 28 are improper and should be reversed. Because claims 2-3, 7, 9-15, 19-21, 23-25, 27, 29-32, 46, and 62-65 depend either directly or indirectly from claims 1 and 28 the rejections of claims 2-3, 7, 9-15, 19-21, 23-25, 27, 29-32, and 62-65 are also improper and should be reversed.

**d. The Examiner Has Not Presented A Prima Facie Case For The
35 USC 102(e) Rejections Of Claims 3, 7, 9-15, 19-21, 23-25, 27,
29-36, 39-42, 45-46 And 62-65**

The examiner has not presented a prima facie case for the 35 USC 102(e) rejections of claims 3, 7, 9-15, 19-21, 23-25, 27, 29-36, 39-42, 45-46 and 62-65. Specifically, the examiner has made no remarks addressing any limitation defined by these claims. The examiner's remarks of record address only the limitations 1, 2, 4, 5, 16, 26, 28, and 44. See the office action mailed January 7, 2005 lines 20-26, and page 9 line 17 to page 10 line 20. The examiner (or the Board, if the Board is the first body to raise a particular ground for rejection) "bears the initial burden . . . of presenting a prima facie case of unpatentability." *In re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992).

The applicant pointed out that the examiner did not present a prima facie case in the response filed October 7, 2004. In the final office action filed January 7, 2005; however, the examiner did not address the Applicant's remarks by presenting a prima facie case for claims 3, 7, 9-15, 19-21, 23-25, 27, 29-36, 39-42, and 45-46. Furthermore, the examiner now rejects claims 62-65 without presenting a prima facie case of anticipation. Thus, the examiner has not met the burden for showing a prima facie case of anticipation by Swix of claims 3, 7, 9-15, 19-21, 23-25, 27, 29-36, 39-42, 45-46, and 62-65. Therefore, the rejections of claims 3, 7, 9-15, 19-21, 23-25, 27, 29-36, 39-42, 45-46, and 62-65 should be reversed.